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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,654	04/27/2001	Haruhiko Kinoshita	048369/0123	7693
22428 7590 10/31/2007 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER BORLINGHAUS, JASON M	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 10/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/842,654	KINOSHITA, HARUHIKO	
	Examiner	Art Unit	
	Jason M. Borlinghaus	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 22 – 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich (US Patent 5,940,843) in view of Disclosed Prior Art (specification, pp. 1 – 4) and Official Notice.

Zucknovich discloses a corporate rating (information/opinion) system:

- wherein a communication terminal of a corporate rating business entity (research provider/contributor) engaging in a business of performing corporate ratings (research/review) having said communication terminal (networked workstation terminals), a

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communication terminal of one or a plurality of enterprises (research provider/contributor) each having said communication terminal (networked workstation terminals) and each desiring a corporate rating (research/review), and having a relationship with an server (repository server) and said corporate rating business entity (research provider/contributor), said each one of said target enterprises (research provider/contributor), and are mutually electrically connected via an appropriate communication circuit (network) (see abstract; col. 1, line 22 - col. 2, line 60); and

- wherein said server (repository server) comprises storage means for storing business information (research) indicating general business activities of each one of said target enterprises (companies), separately, into one of a specific areas of said storage means provided in said server and wherein access to said access to such records are controlled based upon the relationships between parties. (see col. 1 - col. 4).

Disclosed Prior Art discloses a corporate rating system wherein:

- a corporate rating business entity in a business of performing corporate ratings, one or a plurality of enterprises (specific enterprise) having a relationship with said corporate rating business entity and desiring a corporate rating of itself. (see p. 1, lines 15 - 17); and

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- an information source are mutually electrically connected via a communication circuit (network). (see p. 1, lines 17 - 22);
- wherein business information indicating general business activities, including at least financial (financial report), accounting (accounting report) and tax information (tax report) for each target enterprise is stored at said information source for each said target enterprise is stored at said information source for each target enterprise. (see p. 1, lines 21 - 27);
- said system comprising a function whereby said corporate rating business entity having an proprietary corporate rating software obtains required information with regard to said target enterprise desiring a corporate rating from said information source and performs a corporate rating for said target enterprise using said proprietary corporate rating software. (see p. 1, line 27 - p. 2, line 2);
- said operation of obtaining business information indicating general business activities of each enterprise (via computer network) and said operation of performing a corporate rating with respect to each said enterprise at said corporate rating business entity are performed by a computer (via proprietary corporate rating method software). (see p. 1, line 15 - p. 2, line 2);
- use of a communication circuit (computer network/telephone) to obtain an accounting report. (see p. 1, lines 15 - 24);

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- production of accounting report by accounting firm (see p. 2, line 23 - p. 3, line 2);
- said accounting firm views or downloads business information (contained within ledger) indicating general business activities, that include at least one of financial, accounting, and tax information of each target enterprise. (see specification, p. 3, lines 14 - 27);
- based on said business information (ledger), evaluates details of closing account of said enterprise (closing the books). (see p. 3, lines 14 - 27);
- issues a document certifying the accuracy and appropriateness of details of closing account of said enterprise (see p. 3, line 28 - p. 4, line 2);
- said corporate rating business entity refers to the signature (accounting firm signature on financial accounting report) and executes a corporate rating evaluation of a prescribed enterprise in accordance with the signature. (see p. 4, lines 3- 17);
- wherein said business information (disclosure documents) of each target enterprise (specific enterprise) is provided to said corporate rating entity by each said target enterprise (specific enterprise) via said communication circuit (computer network). (see p. 1, lines 15 - 24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Zuchnovich by incorporating the business

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rating methodology, as disclosed by Disclosed Prior Art, into the business rating information transmission, storage and dissemination system, as disclosed by Zuchnovich, allowing for full automation of the corporate rating methodology within a computerized system.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the business rating method, as disclosed by Disclosed Prior Art, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Examiner takes **Official Notice** that the use of an application service provider for management and use of applications, and processing of information in a network environment is old and well known in the arts of information technology. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Zucknovich and Disclosed Prior Art by incorporating an application service provider, as is old and well known, as such use of such technology is standard and conventional in network environments.

Response to Arguments

Applicant's arguments filed 6/19/07 have been fully considered but they are not persuasive.

Claim Rejections – Publicly accessible information

Applicant argues that the corporate rating business entity (research provider) in Zucknovich generates its ratings (reviews) based upon “publicly accessible information” of the reviewed companies. Applicant further asserts that Zucknovich lacks a mechanism for companies to provide their own “proprietary” or “non-publicly-available information” to the rating business entity.

Examiner was unable to locate a disclosure by Zucknovich that the ratings generated were based upon “publicly accessible information” nor that the ratings were limited to the input of such “publicly accessible information.”

Furthermore, Zucknovich discloses that information within the system is submitted by contributors, said contributors establishing the access privileges of their submitted information. (see col. 79, line 21 – col. 81, line 64). For example, contributors can establish access privileges stating that only their own employees are permitted access to submitted documents, while all non-employees are prevented access. (see col. 81, lines 1 –7). This does not demonstrate the transmission or processing of publicly accessible information but rather the ability to transmit public or private information based upon access settings.

Claim Rejections – Network communication

Applicant argues that Disclosed Prior Art does not teach “network communications provided to transfer data between parties” but rather manual retrieval and inputting of data into a computerized system.

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First, specification does disclose "network communications provided to transfer data between parties". Specifically, specification states:

In the past, in the case in which a company, a group or other corporate rating business entity performs a corporate rating of a specific enterprise, **the corporate rating business entity itself must use some type of computer network**, documents, **or the telephone** and the like to obtain required with regard to the specific enterprise, or obtain disclosure documents that the specific enterprise issues at a specific time, such as a stock report, a financial report, an accounting report, or a tax report or the like, **in order to obtain the required information**, or else a worker from the corporate rating business entity visits the specific enterprise to obtain the required information, and, based on information with regard to the specific enterprise, the corporate rating business entity uses its proprietary. (emphasis added – p. 1, lines 15 – 30).

Examiner asserts that such Disclosed Prior Art discloses network communications (use of a computer network or telephone) provided to transfer data (information) between parties.

Second, even if Disclosed Prior Art failed to disclose network communications for data transmission, such network communications would have been obvious when Disclosed Prior Art was read in combination with Zucknovich, as Zucknovich discloses transmission, collection and dissemination of data through a communications network comprising terminals of target enterprises (contributor workstations), an ASP (web server) and a corporate rating business entity (central site). (see abstract and fig. 1).

Furthermore, while Applicant gives particular weight to the claim recitation of an ASP (application service provider), the common and conventional definition of such term is a business that provides computer-based services to customers over a network. In Zucknovich, the system is providing computer-based services

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to customers (viewers) over a network, namely the dissemination of corporate ratings and reviews. (see abstract).

Claim Rejections – Contracts

Applicant argues that Zucknovich does not teach “the checking of specific contracts between various entities”. However, claim limitations do not claim the checking of contracts between various entities. Rather, claim limitations claim that parties have (1) a contract with the ASP and (2) that contract is checked prior to allowing parties access to information of the ASP.

As Applicant notes, in Zucknovich, “a user who preliminar[ily] registers for a service from a financial research provider is provided with pertinent” business information. (see Arguments, p. 13).

Such registration is the establishment of a contractual relationship between the ASP and its users, and the ASP checks it prior to allowing parties access to information of the ASP. (see col. 3, line 13 – col. 4, line 10).

Claim Rejections – Updating

Applicant argues that the claimed invention does not have the same “drawback” as the Disclosed Prior Art in regards to “the updating of information of a target enterprise.”

However, whether the claimed invention has the same “drawback” as the Disclosed Prior Art is irrelevant, as the crux of the analysis is whether the prior art discloses or suggests the claim limitation.

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Furthermore, Examiner was unable to locate a claim limitation regarding the updating of information in the pending claims. Examiner assumes that the Applicant is paraphrasing and was referring to the periodic transmission of data through the system.

Applicant argues that neither Zucknovich nor Disclosed Prior Art teach nor suggest providing business information to an entity periodically via a network.

Disclosed Prior Art states:

The corporate rating business entity 100 obtains the financial accounting report issued by the target enterprise 110, verifies its content, and uses the method of inquiring about any unclear points by visiting or via the telephone with the target enterprise 110 (step A5).

After the above, the target enterprise 110 makes a response to the questions from the corporate rating business entity 100 (step A6).

Finally, the corporate rating business entity 100 considers the response from the target enterprise, and decides and announces a rating (step A7). (see p. 4, lines 8 – 18).

Examiner asserts that the Disclosed Prior Art discloses the target enterprise providing business information (accounting report, responses to questions) periodically via a network (via telephone).

Claim Rejection – Electronic signature

Applicant argues that neither Disclosed Prior Art nor Zucknovich disclose “said accounting firm can evaluate closing account details of said specific target enterprise and issue an electronic signature certifying the accuracy and appropriateness of said closing account details of said specific target enterprise.”

Disclosed Prior Art states:

Of the above, the financial accounting report 140 of the target enterprise 110 is produced with the cooperation of an accounting firm 120 commissioned by the target enterprise 110, and if the accounting firm 120

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judges that the financial accounting report of the target enterprise is correct, the target enterprise receives a certification of the properness and appropriateness thereof, and makes the report public. (see p. 2, line 23 – p. 3, line 2).

Examiner asserts that Disclosed Prior Art discloses an accounting firm evaluating the closing account details of said specific target enterprise and issuing a signature (certification) certifying the accuracy and appropriateness of said closing account deals of said specific target enterprise.

Disclosed Prior Art does not teach that the signature is an electronic signature.

Zucknovich discloses that electronic documents submitted are signed with electronic signatures (contributor ID). (see col. 11, lines 41 – 55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Zucknovich and Disclosed Prior Art by incorporating the signing of accounting reports, as disclosed by Disclosed Prior Art, by electronic signature, as disclosed by Zucknovich, allowing for the signing and certification of electronic documents in a computerized environment.

Claim Rejection – Improvement over conventional systems

Applicant's arguments that the claimed invention is an improvement over conventional systems due to "more accurate corporate rating[s]" and a "high[er] level of trust" are irrelevant as such arguments are directed toward concerns outside the scope of the claims.

Official Notice – ASP

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In response to the applicant's traversal of Official Notice finding(s) in previous office action, Examiner asserts that the traversal is inadequate.

Adequate traversal is a two-step process. First, applicant(s) must state their traversal on the record. Second and in accordance with 37 C.F.R. 1.111(b) which requires applicant(s) to specifically point out the supposed errors in the Office Action, applicant(s) must state why the Official Notice statement(s) are not to be considered common knowledge or well known in the art.

In this application, while applicant(s) have clearly met step (1), applicant(s) have failed step (2) since they have failed to argue why the Official Notice statement(s) are not to be considered common knowledge or well known in the art. Because Applicant(s)' traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. *See MPEP 2144.03.*

Applicant's arguments concerning Examiner's taking of Official Notice is not directed toward whether the asserted fact is common knowledge or well known in the art. Rather, the Applicant's arguments are directed toward the Examiner's motivation to modify or combine the prior existing elements, which is a totally separate issue.

Furthermore, Applicant's arguments that one of ordinary skill in the art would not be motivated to modify or combine the prior existing elements are irrelevant, as such arguments are directed toward concerns outside the scope of the claimed invention. Applicant's arguments are directed toward "security leaks" and the protections of "proprietary information" may be pertinent to the financial viability or market success of utilizing an ASP in such a fashion, such arguments

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are irrelevant in regards to whether it would have been obvious to one of ordinary skill to combine prior existing elements.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

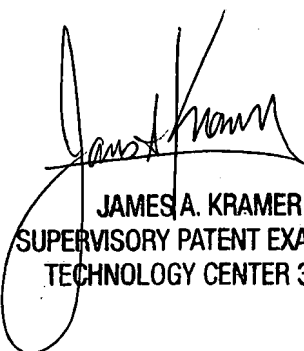
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason M Borlinghaus (JMB)

October 28, 2007



10.29.07
JAMES A. KRAMER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600